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July 26, 2004

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From: Brian M. Dugan

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Our File No.: Docket No. BUR920010063US1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants | : | Anthony Richard Bonaccio et al. |
| Serial No. | : | 09/682,473 |
| Filed | : | September 6, 2001 |
| For | : | CLOCK SIGNAL DISTRIBUTION UTILIZING DIFFERENTIAL SINUSOIDAL SIGNAL PAIR |
| Examiner | : | An T. Luu |
| Group Art Unit | : | 2816 |

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**TOTAL NUMBER OF PAGES INCLUDING THIS PAGE:** 8

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPELLANTS' REPLY BRIEF**

Dear Sir:

This is Appellants' Reply Brief in response to the Examiner's Answer, mailed May 26, 2004, in the above-identified Appeal. Entry of this Appellants' Reply Brief is respectfully requested.

Independent claims 8 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wissell et al., U.S. Patent No. 6,184,736 (Wissell) in view of Matsumoto et al., U.S. Patent No. 5,448,188 (Matsumoto). Appellants respectfully submit that

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Signature 7/26/04 Date

Brian M. Dugan
(*name of person certifying*)

there is no teaching or motivation in Wissell or in Matsumoto for combining their respective teachings in the manner espoused by the Examiner and that any such combination fails to render claims 8 and 13 unpatentable. Appellants further respectfully submit that the Examiner improperly utilized hindsight in rejecting claims 8 and 13.

In view of the arguments provided herein, Appellants respectfully submit that the Examiner's rejection of claims 8 and 13, over Wissell in view of Matsumoto, is untenable and fails to establish a prima facie case of obviousness. Accordingly, Appellants respectfully request that the Examiner's rejection of claims 8 and 13 be reversed.

**DEFINITION OF DIFFERENTIAL SINUSOIDAL SIGNAL PAIR**

Paragraph 18 of Appellants' specification defines the term "differential sinusoidal signal pair" as "a pair of sinusoidal wave forms, that are substantially equal in frequency and amplitude but that are substantially 180° out of phase with each other" (Emphasis added). Appellants note that generation of a differential sinusoidal signal pair, as so defined and claimed, and generation and distribution of a clock signal therefrom, are not disclosed or suggested by Wissell. As stated in Appellants' Brief filed December 26, 2003, the clock signals of Wissell are 90° apart, not 180° apart. The Examiner asserts that "any pair of signals having significant non-overlapped portions can be

considered as being 'differential'" and looks outside of Appellants' specification to U.S. Patent 6,469,547 to support his position. (Examiner's Answer, mailed May 26, 2004, page 5, lines 7-13). However, the MPEP states clearly that the words of a claim "must be given their plain meaning *unless applicant has provided a clear definition in the specification*", citing In re Zletz, 893 F.2d 319 (Fed. Cir. 1989) and MSM Investments Co. v. Carolwood Corp., 259 F.3d 1335 (Fed Cir. 2001). As described above, Appellants' specification clearly defines "differential sinusoidal signal pair". Accordingly, the Examiner's definition is untenable and his primary reference (Wissell) fails to show the use of differential sinusoidal signal pairs as defined and claimed by the Appellants. Appellants respectfully request that the Examiner's rejection of claims 8 and 13 be reversed.

**NO MOTIVATION TO COMBINE/USE OF HINDSIGHT**

Appellants submit that the Examiner failed to point to any teaching or motivation in Wissell or in Matsumoto for combining their respective teachings in rejecting claims 8 and 13. In re Dembiczak, 175 F.3d 994; In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998).

In In Re Dembiczak, the Court of the Appeals for the Federal Circuit stated:

> "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to

combine prior art references." In re Dembiczak, 175 F.3d at 999.

Further, the Court stated that "... the showing must be clear and particular." In re Dembiczak, 175 F.3d at 999.

In discussing Wissell in the Examiner's Answer, the Examiner noted:

> "Wissell discloses in figure 2 an apparatus comprising a generating circuit 42 for generating a differential signal pair (42a and 42b); a distribution circuit (blocks 48 and lines 24) coupled to the generating circuit to distribute the differential signal pair on the IC; a plurality of clock receiver circuits (receiver circuit 32) coupled to the distribution circuit to receive the sinusoidal signal pair as partially required by claim 13. ***Wissell does not disclose the receiver circuit to output a local clock signal as recited in claim.***" Examiner's Answer, mailed May 26, 2004, page 3, lines 11-16 (emphasis added).

The Examiner, discussing Matsumoto, further noted:

> "Matsumoto discloses in figure 1 a receiver circuit for producing a clock output signal by employing both of the sinusoidal signal pair (i.e., generating a ***differential*** sinusoidal signal pair comprising of a first sinusoidal signal V1 and a second sinusoidal signal V2; and generating a clock signal Vout from the differential pair for the IC by employing both the first and second sinusoidal signals to form the clock signal." Examiner's Answer, mailed May 26, 2004, page 3, lines 16-21 (emphasis in original).

To support the Examiner's asserted combination of Wissell and Matsumoto in rejecting claims 8 and 13, the Examiner stated:

> "It would have been obvious to one skilled in the art at the time the invention was made to incorporate the teaching of Matsumoto into that of Wissell because a receiver circuit can be implemented in many different ways to accommodate the requirement of particular application. A skilled artisan would have been motivated to combine these references to produce a stabilized clock output signal for a distribution circuit by mixing corresponding a pair of differential sinusoidal signals from a plurality of pairs of differential

sinusoidal input signals." Examiner's Answer, mailed May 26, 2004, page 3, line 21, to page 4, line 5.

As the above statements evidence, the Examiner, at best, provides only broad and conclusory statements which fail to support the asserted combination of Wissell and Matsumoto. The Court of Appeals for the Federal Circuit has stated that "[b]road conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'." In re Dembiczak, 175 F.3d at 999. Appellants further submit that the Examiner's broad and conclusory statements, in support of the asserted combination of Wissell and Matsumoto, amount to the Examiner's utilization of hindsight, which is improper. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Appellants further respectfully submit that the Examiner's statements, in support of the asserted combination of Wissell and Matsumoto, also lacked the clarity and particularity which is required and dictated by controlling case law. In re Dembiczak, 175 F.3d 994.

The Examiner, in relying on Wissell as the primary reference, recognized a significant distinction between the present invention and Wissell. The Examiner noted that "Wissell does not disclose the receiver circuit to output a local clock signal as recited in claim." Examiner's Answer, mailed May 26, 2004, page 3, lines 15-16.

The Examiner then improperly relied upon Matsumoto in an attempt to supply missing elements of what would appear to be claim 13. The Examiner then proceeded to extend his rejection of claim 13 to claim 8. In particular, the Examiner stated the following: "As to claim 8, it is rejected for reciting methods and/or steps derived from the apparatus rejected in claim 13 noted above.", Examiner's Answer, mailed May 26, 2004, page 4, lines 6-7. The Examiner's broad and conclusory reasoning in support of the asserted combination of Wissell and Matsumoto provides clear support for Appellant's position that the Examiner used hindsight in rejecting claims 8 and 13.

The Court of Appeals for the Federal Circuit in In Re Rouffet, stated:

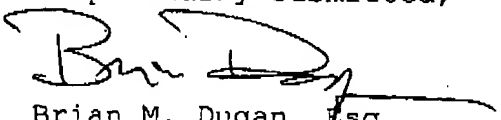
> "Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" In Re Rouffet, 149 F.3d at 1357 (Fed. Cir. 1998).

In view of the foregoing, Appellants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of claims 8 and 13. Appellants further submit that Claims 8 and 13 are patentable over Wissell in view of Matsumoto. In this regard, Appellants

respectfully submit that the Examiner's rejection of claims 8 and 13 is untenable, improper, and should be reversed. Accordingly, Appellants respectfully request that the Examiner's rejection of Claims 8 and 13 be reversed.

No fees are believed to be necessary for entry of this Reply Brief. However, if any fees are required, please charge deposit account no. 04-1696 accordingly.

Respectfully Submitted,



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Dated: July 26, 2004
Tarrytown, New York